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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/960,647	09/24/2001	Jean-Jacques Claisse	CLAISSE=2	6513

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BROWDY AND NEIMARK, P.L.L.C.
624 Ninth Street, N.W.
Washington, DC 20001

EXAMINER

NORDMEYER, PATRICIA L

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 10/21/2003

15

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/960,647

Applicant(s)

CLAISSE ET AL.

Examiner

Patricia L. Nordmeyer

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-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 27-46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 27-46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: |

DETAILED ACTION

Withdrawn Rejections

1. The 102 and 103 rejections of record in Paper #12, Pages 2 – 9 are withdrawn due to Applicant's amendments in Paper #14.

New Rejections

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 32, 35, 38, 41 and 43 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrase “a base portion which is a length of a section” in claims 32, 35, 38, 41 and 43 is unclear, which render the claims vague and indefinite. It is unclear from the claim language what is meant by the phrase since claims from which the above mentioned claims depend do not refer to length of an article.

Clarification/correction is required.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 27 – 32 and 36 – 46 are rejected under 35 U.S.C. 102(b) as being anticipated by Thorp et al. (USPN 5,914,665).

Thorp et al. discloses a plastic cover having a constant thickness and shape (Figure 1, #17 and Column 3, lines 37 – 39) having a weakened sections that form a longitudinal collection of blind holes with an oblong shape covered with a continuous web of plastic that are punched out when the openings are needed (Figure 1, #131, 134 and 136 and Column 4, lines 30 – 37). The weakened area may be formed by a succession of through openings, perforations, cuts and grooves through the wall of the unit (Column 5, lines 63 – 67). As seen in Figure 2, the article is made with a base portion and a cover.

Regarding the plastics material section being made by the method of producing a part, forming an opening, heating the part with a probe and using a punch to modify the part to form a hole or hole precursor in claim 18, the determination of patentability for a product-by-process claim is based on the product itself and not on the method of production. If the product in the product-by-process claim is the same or obvious from a product of the prior art, the claim is

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unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 946, 966 (Fed. Cir. 1985) and MPEP §2113. In this case, the limitations of producing a part, forming, heating and punching are methods of production and therefore do not determine the patentability of the product itself. Process limitations are given little or no patentable weight. The method of forming the product is not germane to the issue of patentability of the product itself. Further, when the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claim in a product-by-process claim, the burden is on the Applicant to present evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. *In re Brown*, 459 F.2d 531, 173 USPQ 685 (CCPA 1972); *In re Fessman*, 489 F.2d 742, 180 USPQ 324 (CCPA 1974).

Regarding the limitations of adapting to receive fixation screws and constituting means for receiving fixation screws in claims 45 and 46, it has been held that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 33 – 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thorp et al. in view of Ogasawara et al. (USPN 6,089,723).

Thorp et al. discloses a plastic cover having a constant thickness and shape (Figure 1, #17 and Column 3, lines 37 – 39) having a weakened sections that form a longitudinal collection of blind holes with an oblong shape covered with a continuous web of plastic that are punched out when the openings are needed (Figure 1, #131, 134 and 136 and Column 4, lines 30 – 37). The weakened area may be formed by a succession of through openings, perforations, cuts and grooves through the wall of the unit (Column 5, lines 63 – 67). As seen in Figure 2, the article is made with a base portion and a cover. However, Thorp et al. fails to disclose a through-hole bordered by a peripheral web.

Ogasawara et al. teach weakened sections that form a longitudinal collection of through holes with a peripheral web of plastic used for the placement of screws (Figure 3, #15) in a plastic cover (Column 1, line 31) for the purpose of securely attaching a base cover flush to a base.

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It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided the through holes with a peripheral web of plastic in Thorp et al. in order to securely attach a base cover flush to a base as taught by Ogasawara et al.

8. Claims 27 – 31, 33, 34, 36, 37, 39, 40 and 42 rejected under 35 U.S.C. 103(a) as being unpatentable over Thorp et al. (USPN 5,914,665).

Thorp et al. discloses a plastic cover having a constant thickness and shape (Figure 1, #17 and Column 3, lines 37 – 39) having a weakened sections that form a longitudinal collection of blind holes with an oblong shape covered with a continuous web of plastic that are punched out when the openings are needed (Figure 1, #131, 134 and 136 and Column 4, lines 30 – 37). The weakened area may be formed by a succession of through openings, perforations, cuts and grooves through the wall of the unit (Column 5, lines 63 – 67). As seen in Figure 2, the article is made with a base portion and a cover.

It is well settled that a particular shape of a prior invention carries no patentable weight unless the applicant can demonstrate that the new shape provides significant unforeseen improvements to the invention. See *In re Seid*, 161 F.2d 229, 73 USPQ 431 (CCPA 1947). Also, see *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966) (the court held that the configuration of the claimed disposable plastic nursing container was a matter of choice which a person of ordinary skill in the art would have found obvious absent persuasive evidence that the

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particular configuration of the claimed container was significant.) In the instant case, the application does not indicate any new, significant attributes of the invention due to its shape, which would have been unforeseen to one of ordinary skill in the art. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to change the shape of the openings in the plastic article to an oblong shape. One skilled in the art would have been motivated to do so in order to allow different conduits to enter into the box and have a tight fit between the two articles.

Response to Arguments

9. Applicant's arguments with respect to claims 27 – 46 have been considered but are moot in view of the new ground(s) of rejection. However, since the same prior art is being applied to the new claims, arguments will be responded to below.

In response to Applicant's argument that Thorp et al does not include hole precursors since it mentions a small number of slot making break away areas, according to the definition of hole precursors found in the specification on page 1, a hole precursor includes "a hole having over a portion of its depth a web including a constriction of its cross section which generally concentric with the hole and intended to be destroyed when a fixing member is inserted", which is being accomplished by the slots in Thorp et al. The material over the slot is being destroyed to allow for connection of an element.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia L. Nordmeyer whose telephone number is (703) 306-5480. The examiner can normally be reached on Mon.-Thurs. from 7:00-4:30 & alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Y. Pyon can be reached on (703) 308-4251. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Patricia L. Nordmeyer
Examiner
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[Signature]
HAROLD PYON
SUPERVISORY PATENT EXAMINER

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